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09/868,740	06/19/2001	Paolo Cittadini	6502-1515	6536

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EXAMINER

TRAN A, PHI DIEU N

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,740

Applicant(s)

CITTADINI ET AL.

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-17 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. PRODUCT BY PROCESS CLAIM:

“ The subject matter present is regarded as a product by process claim in which a product is introduced by the method in which it is made. It is the general practice of this office to examine the final product described regardless of the method provided by the applicant.”

Claim 6 “ by means of injection molding” being treated with respect to the above Office policy.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Second to last line “ no means being associated” is indefinite. It is unclear what applicant is trying to claim. If applicant is referred to no other attachment means besides the ones already claimed be associated to the continuous support element, the claim needs to clearly state so.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6, 10-11 of U.S. Patent No. 6136407 in view of Kraus. 4216637.

Patent No. 6136407 claims 4-6, 9-11 shows all the claimed limitations except for undercuts acting in opposition on the corresponding bearing portion of the continuous support element, the support element not being made of resilient material.

Kraus discloses undercuts (72, figure 14) acting in opposition on the corresponding bearing portion of the continuous support element.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Patent No. 6136407 claims 4-6, 10-11 to show undercuts acting in opposition on the corresponding bearing portion of the continuous support element, the support element not being made of resilient material because the undercuts would enable the sliding and holding of the projections to the support element, and having the support element not being made of resilient material would secure the fastening of the continuous support to the main bar.

Per claims 9-12, Patent No 6136407 claim 9 as modified shows all the claimed limitations except for the main section bar being substantially C-shaped cross section.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Patent No. 6136407 claim 4's modified structure to show the main section bar being substantially C-shaped section because C-shaped cross section is well-known in the art

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for providing a support structure with an attachment channel for securing other structure to the channel.

Per claims 13-15, Patent No. 6136407 claim 9 as modified inherently shows the support element having a pre-set number of attachment seats delimited at least in one side of the continuous element by a peripheral lip defining an open line connected to the subsequent and to the preceding seat.

Per claim 16, Patent No. 6136407 claim 9 as modified shows all the claimed limitations. The claimed method for manufacturing of a molding element and for assembling the same to a motor vehicle would have been the obvious method steps of manufacturing of a molding element and for assembling the same to a motor vehicle in Patent No. 6136407 claim 9's modified structure.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 8-15, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyer (4011635).

Meyer figure 1 shows a molding having a main section bar (28) of elongated conformation, attachment means (38) operatively associated to the main section bar, said means having a continuous support element engaged to the main section bar, the support element presenting a pre-set number of attachment seats (figure 3, 49, 48) located at a pre-set mutual

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distance suitable for engagement with the corresponding projections carried by the securing area, longitudinal seat (the slot formed by the molding) receiving the continuous support element (figure 1), the longitudinal seat presenting in cross-section a longitudinal opening to allow access to the attachment seats and undercuts (34) acting in opposition on a corresponding bearing portion (56, 58) of the continuous support element, the main section bar being capable of preventing extraction of the attachment means through the longitudinal opening, the bar and the support element being made of non-resilient material, the support element being inserted in the corresponding longitudinal seat, the support element being attached to the longitudinal seat only when it is separated from the body, the support element being directly and exclusively attached to the main section bar and to the projections (20, 14) carried by the securing area in the assembly state, no means are associated to the support element for directly attaching the same to the body, the support element having bearing portion (58, 56) acting in opposition to the undercut to prevent extraction of the attachment means through the longitudinal opening, the longitudinal seat having with at least one end an insertion opening (figure 2, the opening of the molding) to receive the continuous support element, a finish coating associated to an outer side (the outside of the molding, the coating being its own molding skin as the coating is not yet defined) engaged on the main section bar, the main section bar being a stiffening metal core (col 1 line 43), the main section bar being substantially "C" shaped cross section (figure 1), the continuous support element presenting a pre-set number of attachment seats (49, 48) delimited at least in one side of the continuous element destined to face the body by a peripheral lip (the edges 46) defining a closed line, the peripheral lip delimiting the attachment seat defines at least an area for the insertion of the fastening projections and at least an area for blocking the

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fastening projections in an axial direction motion of the molding element away from the body (the narrower section of the element), the fastening projections of the body having a head and a connecting stem (12) between the head and the body, the head presenting a radial dimension greater than the radial dimension of the stem, the peripheral lip presenting a projecting portion (the flat section between and below the flanges 38) defining at least an undercut set to act in opposition on a corresponding arrest portion of the head of the projection, the continuous support element presenting a pre-set number of attachment seats (49, 48) which delimited at least in one side of the element destined to face the body by a peripheral lip defining an open line (46) connected to the subsequent and to the preceding seat, the peripheral lip delimiting the attachment seat defining at least a large area (49, 48), at least a small area (figure 3, area 46, and the area to the far left) for blocking the fastening projection in an axial direction of motion of the molding element away from the body.

3. Claims 1, 5, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Molnar (4386799).

Molnar shows molding element having a main section bar (figure 2, the bar below the molding 24) of elongated conformation, attachment means (24) having a continuous support element presenting a pre-set number of attachment seats (the channels 28, 76, figure 2) located at a pre-set mutual distance, a longitudinal seat (the opening channel of the bar) obtained on the main section bar for receiving the support element, the longitudinal seat presenting in cross-section a longitudinal opening to allow access to the attachment seats and undercuts (figure 3, the area under 80) acting in opposition on a corresponding bearing portion of the support element, the main section bar being capable of preventing the extraction of the attachment means through

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the longitudinal opening, the bar and the support element being made of non-resilient material (col 5 lines 19-24, inherently so as they are made not to deflect), axial locking means (figure 1, caps 16, 108) operatively interposed between the main section bar and the attachment means, the support element presenting a pre-set number of attachment seats (the channel) delimited at least in one side of the continuous element (the side opposite the channel with resilient part 40) destined to face the body, by a peripheral lip (figure 2, 38) defining a closed line (it is unclear what closed line means yet).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (4011635).

Meyer shows all the claimed limitations. The claimed method for the manufacturing and assembly of the molding element to a motor vehicle body would have been the obvious method of manufacturing and assembling the molding element to a motor vehicle body with Meyer's structure.

Allowable Subject Matter

6. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: prior art does not show the molding element having a flexible seal lip extending longitudinally along substantially the entire development of the molding element itself and having a base portion engaging the main section bar in combination with the main section bar having an elongated conformation, the bar having a longitudinal opening which receives the support element, the bar having undercuts acting in opposition on a corresponding bearing portion of the support element to prevent the extraction of the attachment means from the bar, the bar and the supporting element being non-resilient material, the support element presenting a pre-set number of attachment seats located at a pre-set mutual distance for engagement with the corresponding projections carried by the securing area.

Response to Arguments

8. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different molding elements.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Phi Dieu Tran A *PA*
December 16, 2002

LANNA MAI
SUPERVISORY PATENT EXAMINER
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